

#### REMARKS/ARGUMENTS

Claims 1-16 are pending in this Application, and stand rejected under 35 U.S.C. §103(a).

In this paper, Applicants have amended claims 1, 5, and 9 as shown above to more particularly and distinctly claim the subject matter that Applicants believe to be their invention. New claims 17-29 have been added. No new matter has been added by the foregoing amendment, full support therefor being shown in the drawings and specification as filed.

Applicants submit that claims 1-29 are allowable. Continuing examination and reconsideration of the Application is respectfully requested in view of the foregoing amendments and the following remarks.

#### **Claim Rejections - 35 USC §103(a)**

Claims 10 and 11 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,140,933 to Bugno in view of U.S. Patent No. 6,094,027 to Willmore et al. The rejection is traversed.

Bugno '933 discloses an internal vehicular rearview mirror assembly having a mirror carrier 120 with a reflective element 140 mounted thereon. The focus of the Bugno '933 reference is the provision of a compass display 400 to the driver which is corrected by a tilt detector 500 for detecting when the mirror carrier 120 has been tilted from a prior position, and for generating and transmitting a tilt detection signal to a processing circuit 380 for compensating the compass reading on the display 400 or recalibrating the compass display 400. The processing circuit 380 includes a microprocessor 64 for controlling the tilt detector 500, compass sensors 440, 460, an electrochromic element 71, a temperature sensor 69, and the like, and a non-volatile memory 66.

Willmore '027 discloses an integrated tilt actuator and position indicator 22 that comprises a case 34 that houses both the tilt actuator assembly 58-64, 74-78 and the positional indicator assembly 81-86.

The standards for a finding of obviousness must be strictly adhered to. Simply citing one or more prior art references that illustrate different facets of the invention and then concluding that it would be obvious to combine the references to create the applicant's invention is wholly inadequate.

A claimed invention is unpatentable if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art....The ultimate determination of whether an invention would have been obvious under 35 U.S.C. §103(a) is **a legal conclusion based on underlying findings of fact.**<sup>1</sup>

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field....Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

Most if not all inventions arise from a combination of old elements....Thus, every element of a claimed invention may often be found in the prior art....However, **identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention....**Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, **there must be some motivation, suggestion or teaching of the desirability of making the specific combination** that was made by the applicant....Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved....In

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<sup>1</sup> The underlying factual inquiries include (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; and (3) the differences between the claimed invention and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966).

addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references....The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art....Whether the Patent Office Examiner relies on an express or an implicit showing, **the Examiner must provide particular findings related thereto....Broad conclusory statements standing alone are not "evidence."**

*In Re Werner Kotzab*, 217 F.3d 1365; 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000)(citations omitted)(emphasis added).

The Examiner has failed to identify any motivation, suggestion, or teaching of the desirability of combining Bugno '933 with Willmore '027 to arrive at Applicants' invention. There has been no statement identified in the prior art, there has been no discussion of the knowledge of one of ordinary skill in the art or the nature of the problem to be solved, there has been no identification of what the combined teachings, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to one of ordinary skill in the art as required for a showing of motivation. The Examiner has failed to provide any particular findings related to any motivation, suggestion, or teaching of the desirability of combining Bugno '933 with Willmore '027. The Examiner has simply relied upon "broad conclusory statements standing alone," which can only lead to the conclusion that the Examiner is simply relying on impermissible hindsight reconstruction of Applicants' invention.

Bugno '933 relates to a device for correcting a compass display on an internal vehicular mirror when the internal vehicular mirror is repositioned. Bugno '933 in no way relates to a vehicular mirror with a motorized tilt actuator for selectively tilting a reflective element relative to a frame. In fact, it appears the vehicular mirror assembly in the Bugno '933 reference is a manually positionable mirror and in no way relates to a motorized actuator which physically performs the tilting of the mirror relative to a frame. Given the focus in Bugno '933 on correcting electrical outputs from the repositioning of a mirror in order to provide accurate

compass directions displayed in the mirror, there is simply no motivation to combine Bugno '933 with Willmore '027, and the Examiner has identified none.

Even if the combination of Bugno '933 and Willmore '027 were proper, the combination still would not reach the invention of amended claim 1. In pertinent part, amended claim 1 calls for a vehicular rearview mirror assembly, comprising a frame, a reflective element attached at the frame; a motorized tilt actuator attached at the frame and the reflective element, and a positional memory element located away from the tilt actuator coupling the frame with the reflective element, wherein a position of the reflective element relative to the frame is correlated to an output signal from the positional memory element so that movement of the reflective element from a first position to a second position results in a change in said output signal.

Bugno '933 does not disclose a positional memory element located away from a motorized tilt actuator and interposed between a frame and a reflective element, wherein a position of the reflective element is correlated to an output signal from the positional memory element so that movement of the reflective element from a first position to a second position results in a change in the output signal, as called for by amended claim 1. The microprocessor in Bugno '933 is not a positional memory element as described and illustrated in the Application. Bugno '933 also fails to disclose the correlation of an output signal from the positional memory element so that movement of a reflective element from a first position to a second position results in a change in said output signal.

Willmore '027 also does not disclose a positional memory element located away from a motorized tilt actuator, as called for by amended claim 1. The positional indicator assembly in Willmore '027 is located in the same housing as the tilt actuator assembly, adjacent the tilt actuator assembly. Thus, the combination of Bugno '933 and Willmore '027 does not reach the invention of amended claim 1, and claim 1 is therefore patentable.

Claims 2-16 depend, directly or indirectly, from amended claim 1, and are also patentable for the same reasons set forth above with respect to amended claim 1. Applicants request the withdrawal of the rejections, and the allowance of claims 1-16.

Applicants will briefly address new claim 17 in light of the rejection. Claim 17, in pertinent part, calls for a vehicular rearview mirror assembly comprising a frame, a reflective element attached to the frame, a motorized tilt actuator, and a positional memory element contained within a modular housing located away from the tilt actuator coupling the frame with the reflective element, wherein a position of the reflective element relative to the frame is correlated to an output signal from the positional memory element so that movement of the reflective element from a first position to a second position results in a change in said output signal, and wherein the modular housing containing the positional memory element can be selectively coupled to and decoupled from the frame and the reflective element without requiring disassembly of the tilt actuator.

The arguments relative to claim 1 apply equally to claim 17. Furthermore, neither Bugno '933 nor Willmore '027 discloses a modular housing containing the positional memory element which can be selectively coupled to and decoupled from the frame and the reflective element without requiring disassembly of the tilt actuator. Thus, the combination of Bugno '933 and Willmore '027 does not reach the invention of claim 17, and claim 17 is therefore patentable.

New claims 18-29 depend, directly or indirectly, from claim 17, and are also patentable for the same reasons set forth above with respect to claim 17. Applicants request that claims 17-29 be allowed.

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### CONCLUSION

It is respectfully submitted that all of the claims in the application are allowable over the prior art of record. Nevertheless, Applicants are filing a Request for Continued Examination contemporaneously herewith pursuant to 37 C.F.R. §1.114. Prompt notification of allowability is respectfully requested.

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